

REMARKS

Pending claims

Claims 1-17 are pending in the application. The Applicants have canceled claims 2 and 3 and incorporated them into claim 1. The Applicants have also canceled claim 6 and incorporated its features and the features of claim 1 into claim 5. Claim 5 is now an independent claim. Claim 8 has been amended for clarity purposes. Claim 10 has been canceled and its subject matter incorporated into claim 9. Claim 12 has been amended to incorporate the features of claim 9. Claim 12 is now an independent claim. Claims 13, 14 and 17 have been canceled. All amendments to the claims are being made without prejudice. No new matter has been added. Four independent claims are now pending in the application. Payment for an additional independent claim fee is enclosed.

Claim Rejections – 35 USC § 103

In the Action, the Examiner rejects claims 1-17 under 35 USC § 103 based on Ukita (U.S. Pat. No. 6,622,174), Murata (U.S. Pub. App. 2001/0005854) and Kamada (U.S. Pat. No. 6,192,258). The Applicants have amended the claims as shown above and submit that the amended set of claims is patentable over Ukita, Murata and Kamada.

1) Lack of motivation to combine

Ukita relates to a system for sending, converting and adding advertisements to electronic messages sent across a network. In Ukita, when a terminal 1 forwards an electronic mail to a common server device 2, the server 2 attaches advertisement information to the electronic mail, and forwards it to a requested terminal 1.

Murata relates to a system for sending and receiving an e-mail to which a plurality of positional data are attachable. In Murata, positional data from a user database 24 is added to an e-mail at a user terminal 30, and the e-mail is sent to a designated address of user terminal 31 via Internet 13.

Kamada relates to a mobile communication device with a rotary push switch, disclosing

automatic dialing to a given phone number.

In the response filed by Applicants on July 29, 2005, Applicants state that there is no motivation to combine Ukita with Murata, because the information used in Ukita is advertisement information based on user information and the information used in Murata is user information, and that the person skilled in the art would not be motivated to replace advertisement information based on user information with user information.

In the Action, the Examiner disagrees with the Applicants' arguments and cites *In re Keller* to state that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. However, also application of this test leads to a combination which is different from the combination claimed in the Applicants' claims. In particular, in Ukita, advertisement info is sent to a user, the info being a function of the user receiving the message. In Murata, a user seeking a place is being sent information about a party associated with the place sought by the user. Therefore, in Ukita, user information is used in order to select which advertisement to send to that user. In Murata, information about a third party is added to the e-mail once a map is selected.

2) The combination of the references does not teach the combination of the features of claim 1

Moreover, the Examiner should note that claim 1 recites "*adding said item of said user information to the email message.*" In Ukita, no user information is added to the email message, only advertisement information. In Murata, information about a third party is added to the email message. That information about a third party is not user information. In particular, the Examiner should note that claim 1 recites that "*user information correspond[s] to registered users.*" Where is Murata disclosing that the information about the third party corresponds to a registered user?

Further, claim 1 recites that "*said email adding device adds . . . telephone number data to the email message*" and that "*a call operation is initiated to a link indicated by the telephone*

number data based on a predetermined operation." According to the Examiner, such feature is disclosed at column 10, lines 42-47 of Kamada. However, such passage of Kamada, when read in conjunction with Figure 7 of Kamada, only shows the capability to make a phone call to a number shown in the list of Figure 7 without dialing the single digits. The Applicants have reviewed Kamada and have not been able to find where, in Kamada, addition of a phone number to an e-mail message to enable initiation of a phone call is described. Figure 7 in Kamada only shows a directory of addresses, not an e-mail message. Further, there is no mention of addition of a phone number to an e-mail message in the passage at column 10, lines 42-47 cited by the Examiner.

Therefore, claim 1 is deemed to be patentable i) because the person skilled in the art would not be motivated to combine Ukita with Murata and ii) also because the combination of Ukita and Murata does not disclose the above feature of claim 1. Also claims 4, 7, 8 and 15 are deemed to be patentable, at least by virtue of their dependency on claim 1.

3) Claim 9

Independent claim 9 is similar to claim 1. Therefore, the Applicants submit that independent claim 9 is patentable over the cited references for the same reasons as shown with reference to claim 1, together with claim 11, at least by virtue of its dependence on claim 9.

4) Claim 5

With reference to claim 5, such claim recites "*adding said item of said user information to the email message*" similarly to what recited in claim 1. Therefore, the same arguments used above by Applicants can be used to show that claim 5 is patentable over the cited art. Further, claim 5 also recites that the "*user information*" includes "*position information and map link information corresponding to the position information.*" According to the Examiner, such feature is disclosed in paragraphs [0052] and [0062] of Murata. However, claim 5 recites that "*user information correspond[s] to registered users.*" Where is this feature shown or taught in Murata?

Therefore, claim 5 is patentable over the art cited by the Examiner, together with claim 16, at least by virtue of its dependence on claim 5.

5) Claim 12

Independent claim 12 is similar to claim 5. Therefore, the Applicants submit that independent claim 12 is patentable over the cited references for the same reasons as shown with reference to claim 5.

* * *

In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees, which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

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December 30, 2005
(Date of Deposit)

Susan Papp
(Name of Person Depositing)

Susan Papp
Signature
12/30/05
Date

Respectfully submitted,

Alessandro Steinfl

Alessandro Steinfl

Attorney for Applicants

Reg. No. 56,448

LADAS & PARRY

5670 Wilshire Blvd., Suite 2100

Los Angeles, CA 90036

(323) 934-2300

asteinfl@ladas.com

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